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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/527,817

10/24/2005

Philippe Stalder

5019-1003

6462

466

7590

11/14/2008

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EXAMINER

MISKA, VIT W

ART UNIT

PAPER NUMBER

2833

MAIL DATE

DELIVERY MODE

11/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/527,817	Applicant(s) STALDER ET AL.	
	Examiner Vit W. Miska	Art Unit 2833	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/18/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner et al (6618328) in view of Hayakawa (EP 1096641).

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3. Ellner et al disclose a watch case comprising a middle 45,47,49,51, and back cover 163 (Fig. 22) screwed into the middle (col. 7, line9), false back 149 installed against an internal surface of the cover, electronic identification element 147 installed between the cover and the false back. Element 147 is described at col. 6, lines 60-62 as a functional member that “can emit signals (electronic, audio, visual, etc.) to indicate the whereabouts of the watch assembly or of the wearer of the watch assembly etc.”. Such device therefore constitutes and identification element for indicating the location of the watch, as claimed.

4. Ellner et al do not disclose joint for preventing water infiltration between the back and middle. Such joint or seal I taken Official notice of as being conventional in a wristwatch type device in order to provide waterproofing to the watch. It would therefore be obvious for one skilled in the art to provide a seal between the back 163 and middle for this purpose.

5. An antenna is not mentioned in Ellner et al. However, in order for the device to properly emit or receive signals, as suggested at col. 6, lines 60-62, and antenna of some kind would be required. Hayakawa teaches an inductor 210 (antenna) placed at the back cover of a watch for receiving and transmitting signals to an external device inductor 110. It would be obvious for one skilled in the art to provide an antenna in the device of Ellner et al as a necessary component for receiving/transmitting the identification signals suggested and as taught by Hayakawa.

6. With respect to claims 2-3, provision of a decoration on either side of false back 149 would be obvious for one skilled in the art as a means for accommodating additional elements thereon, and as shown in Figs. 20-21 for the bottom side of back 149.

7. Regarding claim 9, it would be obvious for one skilled in the art to coat circuit 147 with resin as an obvious and well known method of sealing and protecting electronic circuits from the effects of environmental conditions.

8. With respect to claim 10, the case material is not mentioned in Ellner et al. However, one of ordinary skill in the art would select appropriate materials for the cover and false back . Plastic and metals are conventional materials for watch cases and therefore suitable for use in Ellner et al. The use of metal would be considered with consideration of the effects thereof on reception of electromagnetic signals associated with the identification device 147. Therefore, one skilled in the art would consider appropriate thickness of the cover 163, if made of metal, such as to permit reception of induction signals from the exterior and provide sufficient protection as a cover.. The selection of the claimed thickness for the cover does not produce any unexpected results and such dimension would therefore be obvious to one skilled in the art. Further with respect to claim 10, the supply of energy by induction is taught by Hayakawa, with inductor 210 serving as an antenna and coupling device for receiving external energy. It

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would be obvious for one skilled in the art to provide such an inductor for supplying energy to the identification device of Ellner et al in order to obviate the need for a power supply.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellner et al and Hayakawa as applied to claim 1 above, and further in view of Sato (6657922). Ellner et al do not suggest a double sided adhesive for securing element 147.

Sato discloses an electronic circuit/antenna (4) being fixed in a cavity (12) by way of a double-sided adhesive (13) (col. 3, lines 5-11). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide a double-sided adhesive, as taught by Sato, to the electronic circuit 147 in Ellner et al, in order secure the circuit in the cavity of the watch case.

Response to Arguments

10. Applicant's comments have been given careful consideration, but are not persuasive. Applicant suggests that it would not be feasible to place an antenna and an identification device in Ellner because the case is made of metal. However, with respect to claim 1, Ellner does not specify the materials for the watch case components.

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Therefore, plastic could appropriately be used as a well known material for these elements. Regarding claim 10 and the use of a metallic cover, applicant has not provided any particular structure to overcome the effects of metal in connection with electromagnetic transmissions. The dimensions recited for the cover are within the range that one skilled in the art would consider in Ellner et al for providing adequate strength to the back of the watch and for allowing for reception communication signals from the exterior to the identification device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vit W. Miska whose telephone number is 571-272-2108. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on 571-272-2009. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vit W. Miska/
Primary Examiner, Art Unit 2833